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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125615
Party	Plaintiff UNIVERSITY OF SOUTHERN CALIFORNIA UNIVERSITY OF SOUTHERN CALIFORNIA ,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 91125615

Serial No. 75/358,031

Mark: **SC (Stylized)**

Filed: September 16, 1997

Published: May 18, 1999

OPPOSER'S RESPONSE TO APPLICANT'S OBJECTIONS TO OPPOSER'S EVIDENCE

Opposer, the University of Southern California ("California"), hereby submits its Response to the "Applicant's Objections to Opposer's Evidence" filed by Applicant University of South Carolina ("Carolina") in the above captioned matter.

I. Response to Applicant's Introduction and General Objections.

Carolina argues that California objected to evidence of a similar type to the evidence submitted by California. As one example, Carolina argues that California objected to Carolina's submission of newspaper articles to show Carolina's fame, while California used newspaper articles to show California's fame.

However, while the evidence may have been of a similar type, the relevance is quite different. As noted in the brief, the fifth *DuPont* factor involves the fame of the plaintiff's mark. For that reason, it is highly relevant that the consuming public has been exposed to SC as reflecting Opposer University of Southern California.

However, there is no relevance to Carolina's alleged fame. First, to the extent that Carolina submits the evidence to show that Carolina was generally well-known as an institution before 1997, there is no connection between that recognition and this case without some evidence that the consuming public knew and recognized Carolina as being associated with the SC mark. As addressed in the brief itself, Burger King may be very well-known, but that fame is not relevant to the question of whether it can use the BIG MAC® mark.

To the extent that Carolina submits the evidence to show that it has received some public exposure after 1997 using the SC mark, this is also not relevant. It does not establish priority before the date of the application. If California has priority as of 1997 (and it does), then Carolina's public use after 1997 is merely an infringement and extended use simply extends the scope of the infringement.

While Carolina attempts to gloss over these differences in an attempt to avoid close scrutiny of the fact that California's evidence is relevant and Carolina's evidence is not, Carolina cannot exclude California's evidence in so facile and superficial a manner. Other than the objections addressed below, Carolina has not provided any basis to object to other evidence and cannot simply object on a "me too" basis where – in fact – the issues are different even though the form of the evidence may be similar.

II. Response to Applicant's Objections to Trial Evidence.

A. Opposer's Exhibit 20.1-2.

Applicant Carolina objected to Opposer's Exhibit 20.1-2 (attached to Opposer's Notice of Reliance No. 1). Opposer's Exhibit 20.1-2 consists of an excerpt from California's first yearbook published in 1898. The exhibit identifies the "University Monogram" as an SC logo consisting of a smaller S within a larger C.

Carolina's Objection	California's Response
Relevance: Carolina asserts that "printing a design in a yearbook does not show trademark usage on services or products sufficient to establish any trademark or service mark rights under the Lanham Act. Moreover, there is no testimony in the record establishing that this 'University Monogram' was used in connection with any athletics or educational services."	While California agrees that the presentation of initials in a yearbook alone is <i>not</i> evidence of trademark usage (<i>see e.g.</i> App. Ex. 446.2), this designation of this logo as the "University Monogram" implies that the logo was more than just a random image on a yearbook page. It is included along with a listing of other formal insignia for the University of Southern California such as the "University Colors" and the "University Yell." [O-Ex. 20.2.] The same logo also appears later on the uniform of a student-athlete, which tends to confirm that the University Monogram was a logo used in a trademark sense in connection with educational services and athletic exhibitions. [O-Ex. 79.4 (1904 picture of California football player).]
Relevance: Carolina asserts that "the monogram appears to depict the letters 'CS' as opposed to 'SC' and there, it has no relevance in these	Although California acknowledges that the logo might be ambiguous to a modern eye, there can be no question that the University Logo for the

proceedings.”	University of Southern California was intended to be understood as an “SC” rather than a “CS.”
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B. Opposer’s Exhibit 21.1-2.

Applicant Carolina objected to Opposer’s Exhibit 21.1-2 (attached to Opposer’s Notice of Reliance No. 1). Opposer’s Exhibit 20.1-2 is a Varsity Handbook for the University of Southern California published by the Young Men’s Christian Association and the Young Woman’s Christian Association.

Carolina’s Objection	California’s Response
Foundation: Carolina asserts that the document was not created by Opposer and therefore lacks foundation.	California did not need to lay any foundation because Carolina <u>stipulated</u> to the admission of the document in the stipulation executed by the parties on or about December 16, 2005 and filed with the Board on December 29, 2005. Specifically, Carolina stipulated that the document was authentic, could be admitted by means of a notice of reliance and qualified as business records and/or ancient documents. Carolina also specifically waived any hearsay objection.
Relevance: Carolina asserts that because the document did not originate with Opposer, it should not be considered as relevant on the issue of trademark usage.	First, California disputes Carolina’s assumption that this was not an official California document. It is the “Varsity Handbook of the University of Southern California” regardless of the fact that it may have been “presented” or sponsored by the Y.M.C.A. and the Y.W.C.A. However, even if it

	<p>had been generated by a third party, it would still be contemporaneous evidence of the trademarks being used by California in 1907-08. There is no reason to believe that the Y.M.C.A. and the Y.W.C.A. chapters at the University of Southern California would not be familiar with the trademarks. In other words, even if this were a third-party document (which California disputes), there is no reason that evidence from third parties is necessarily unreliable.</p>
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C. Opposer's Exhibit 79.2.

Applicant Carolina objected to Opposer's Exhibit 79.2 (attached to Opposer's Notice of Reliance No. 5). Opposer's Exhibit 79.2 is an excerpt from a pictorial history of the University of Southern California containing a 1904 photograph of student Ray Tufts wearing an SC logo as part of his football uniform.

Carolina's Objection	California's Response
<p>Foundation: Carolina asserts that no foundation was laid for the book since no date was provided for the book and nothing is known about the book and there is no foundation laid to allow the fact-finder to determine the veracity of the statements therein.</p>	<p>California did not need to lay any foundation because the Carolina <u>stipulated</u> to the admission of the document in the stipulation executed by the parties on or about December 16, 2005 and filed with the Board on December 29, 2005.</p> <p>Specifically, Carolina stipulated that the document was authentic, could be admitted by means of a notice of reliance and qualified as business records</p>

	and/or ancient documents. California notes that Carolina submitted a similar exhibit for an illustrated history of Carolina. [A-Ex. 90, attached to Applicant's Notice of Reliance No. 2.] ¹
Hearsay within Hearsay: Carolina takes the position that the caption statement is hearsay within hearsay and should be excluded under F.R.E. 801.	<p>At most, this is a single level of hearsay (<i>i.e.</i>, a single out of court statement for the truth of the matter asserted) rather than a double level wherein the book quoted someone else for the truth of what the third-party said. In stipulating that various documents could be treated as business records and/or ancient documents, the parties agreed to accept the statements in such documents and to waive any hearsay objections. The stipulation applied to both parties and allowed the parties to put in evidence that was not questioned and was reliable on its face without unnecessary burden on either the parties or the Board.</p> <p>Had the article said "According to a friend of</p>

¹ Technically, Applicant submitted Applicant's Exhibit 90 under a notice of reliance on printed publications. [Applicant's Notice of Reliance No. 2.] California believes this was in error, since Carolina cites the text of Exhibit 90 for the truth of the matters asserted therein, and 37 CFR § 2.122(e) only allows parties to rely on what the document shows on its face rather than the truth of the matters asserted in the document. T.B.M.P. §704.08; *citing In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed Cir. 1987); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (annual report considered stipulated into evidence only for what it showed on its face) (additional citations omitted). However, since Applicant's Exhibit 90 is also covered by the December 16, 2005 stipulation, Carolina's error was only a matter of form and did not affect the substance. California did not object to issues of form when they would have no impact on the substance.

	<p>Ray Tufts, he only played a single season” then the statement would have contained a second level of hearsay and might be objectionable. Without that second level, however, the parties’ stipulation makes the document admissible since statements of facts in business records and ancient documents can be considered without regard to whether they are hearsay.</p>
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D. Opposer’s Exhibits 79, 80, 88, 89, 92, 95, 96, 98, 99, 105, 107, 108, 109, and 112.

Applicant Carolina objected to Opposer’s Exhibits 79, 80, 88, 89, 92, 95, 96, 98, 99, 105, 107, 108, 109, and 112 (attached to Opposer’s Notice of Reliance No. 5). Opposer’s Exhibits 79, 80, 88, 89, 92, 95, 96, 98, 99, 105, 107, 108, 109, and 112 are excerpts from a pictorial history of the University of Southern California.

Carolina’s Objection	California’s Response
<p>Foundation: Carolina again asserts that no foundation was laid for the book since no date was provided for the book and nothing is known about the book and there is no foundation laid to allow the fact-finder to determine the veracity of the statements therein.</p>	<p>Again, California did not need to lay any foundation because the Carolina <u>stipulated</u> to the admission of the documents in the stipulation executed by the parties on or about December 16, 2005 and filed with the Board on December 29, 2005. Specifically, Carolina stipulated that the documents were authentic, could be admitted by means of a notice of reliance and qualified as business records and/or ancient documents. The parties specifically waived hearsay objections.</p>

	<p>California again notes that Carolina submitted a similar exhibit for an illustrated history of Carolina. [A-Ex. 90, attached to Applicant's Notice of Reliance No. 2.]</p>
<p>Hearsay within Hearsay: Carolina takes the position that the caption statement is hearsay within hearsay and should be excluded under F.R.E. 801.</p>	<p>Again, this is at most a single level of hearsay (<i>i.e.</i> a single out of court statement for the truth of the matter asserted) rather than a double level wherein the book quoted someone else for the truth of what the third-party said. In stipulating that various documents could be treated as business records and/or an ancient documents, the parties agreed to accept the statements in such documents and to waive any hearsay objection. The stipulation applied to both parties and allowed the parties to put in evidence that was not questioned and was reliable on its face without unnecessary burden on either the parties or the Board. The Board may consider the statements made in the pictorial history since they do not qualify as hearsay pursuant to the stipulation of the parties.</p>

D-1. TD-Taylor 21:16-23:11.

Mr. Taylor is a private investigator hired by California to visit and take pictures of collegiate merchandise in stores. Carolina objects to testimony about the organization of merchandise in the stores, as well as to the photographs that Mr. Taylor took which evidenced such organization. Although Carolina lumps the objections to the testimony and the evidence together, California separates the responses because Carolina specifically agreed to the introduction of the documents and so the responses are different.

Carolina's Objection	California's Response
Lack of Foundation/Relevance: Carolina objects that Mr. Taylor "failed to use any systematic approach" and "traveled haphazardly around the southeastern part of the country for several days in an effort to snap photographs at random stores."	Mr. Taylor laid a clear foundation about what he did and his testimony was based on his personal knowledge. Moreover, although no single human being could provide an exhaustive survey of how each and every retail establishment organizes its goods, Mr. Taylor visited more than 130 different establishments in a broad survey without any bias. [TD-Taylor 6:8-7:4, 9:9-14; 14:14-17.] While Carolina suggests that California could have called "store owners" or other sources, that would not have given as broad a view of the marketplace as a whole. Absent any specific reason to believe that Mr. Taylor's travels did not accurately capture at least a significant portion of the marketplace (and Mr. Taylor visited numerous general retail stores, sporting goods stores, and sports specialty stores), the evidence is clearly relevant and Mr. Taylor's

	testimony should be allowed.
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D-2. Opposer's Exhibits 328-351.

As noted above, Carolina now objects to photographic evidence of Mr. Taylor's travels. However, California specifically moved the admission of these documents on the record, and Carolina specifically agreed that it did not have any objections except as to handwriting on one page. [See, e.g., TD-Taylor 46:12-47:4 (admitting proof sheet of all photos without objection, and index explaining travels with objections only to handwriting).]

Carolina's Objection	California's Response
Lack of Foundation/Relevance: Carolina objects that Mr. Taylor "failed to use any systematic approach" and "traveled haphazardly around the southeastern part of the country for several days in an effort to snap photographs at random stores."	Mr. Taylor laid a foundation for each photograph by testifying that he took all of the photographs himself and they were true and accurate reflections of the subjects of his pictures. [See, e.g., TD-Taylor 46:12-17.] Moreover, Carolina specifically agreed to the admission of the documents. [See, e.g. TD-Taylor 46:12-47:4.] To the extent that Carolina objects to the relevance, California incorporates its response to the previous objection and further notes that these photographs are much better evidence of the actual marketplace than the abstract and conclusory testimony from either party.

D-3. Opposer's Exhibits 350-351.

Carolina objects to two exhibits introduced on re-direct in response to Carolina's cross-examination. The two photographs consist of additional pictures of a physical hat that was previously depicted at DSCN1978 in Exhibit 328.

Carolina's Objection	California's Response
Failure to Produce: Carolina argues that the physical hat and these two specific pictures of such hat were not previously produced.	<p>A party is not required to produce each and every possible bit of evidence that it may rely upon.</p> <p><i>Time Warner Entertainment Co. v. Jones</i>, 65 USPQ2d 1650, 1657 (TTAB 2002). There was clearly no prejudice here since California provided relevant samples of California's goods and California also provided one photograph of this hat. (although not the additional two photographs which were taken by counsel during the trial period). To the extent that Carolina suggests that California was obligated to produce <i>every</i> document that is responsive to a document request, it misrepresents the obligations of a party before this Board. TBMP § 402.02 (sufficiently to provide representative samples). Moreover, this evidence was not part of California's case-in-chief or its direct evidence, but was employed only to clarify certain misconceptions that arose out of Carolina's testimony. It was clearly appropriate rebuttal evidence.</p>

F. TD-Kennedy 42:22-43:5, 44:25-50:6; Opposer's Exhibits 4-11.2.

Ms. Kennedy testified as to evidence of actual confusion. Carolina objects to Ms. Kennedy's testimony as well as the printouts from certain websites.

Carolina's Objection	California's Response
Lack of Foundation: Carolina attempts to characterize the specific evidence, and then argues that since there was no evidence about how the web content was created, it is speculation to assert that mislabeling was caused by consumer confusion.	In terms of foundation, there is no question that Ms. Kennedy laid a foundation for the exhibits themselves demonstrating that the exhibits did reflect the websites at issue. In terms of Carolina's other arguments, such arguments go to the weight of the documents rather than their admissibility. The documents speak for themselves.
Relevance: Carolina argues that, absent any evidence that consumers were confused, the documents are irrelevant.	Direct evidence of consumer confusion is exceedingly difficult to uncover, particularly for inexpensive goods sold by retailers far down the distribution chain from the parties at bar. The fact that multiple retailers have been confused about the source of SC branded goods, however, clearly makes it more likely that the marks are confusingly similar. Since the standard for relevance is merely that it makes a relevant fact more or less likely, the material is relevant.
Relevance: Carolina finally argues that one of the hats reflects a mark Carolina's baseball team used during the 1990s through the adoption of the SC	California did not introduce that particular exhibit to show consumer confusion because it does seem that the hat comes from Carolina. Rather,

mark at issue here.	California introduced the exhibit to show that Carolina uses various forms of the SC mark interchangeably and that the consuming public therefore would <i>not</i> understand the mark in Carolina's application as a unique mark with a separate commercial impression but instead would understand that mark as another form of a general SC mark (in which California has prior rights).
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G. Opposer's Exhibit 16.

Opposer's Exhibit 16 is a summary of financial sales of Team Trojan gear. Carolina objects to Opposer's Exhibit 16 on the basis that it is a summary and Carolina asserts that the documents underlying the summary were not provided to Carolina before the day of trial.

Carolina's Objection	California's Response
F.R.E. 1006: Carolina objects to Opposer's Exhibit 16 on the basis that it is a summary and Carolina asserts that the documents underlying the summary were not provided to Carolina before the day of trial.	<p>Carolina does not deny that it was provided the documents underlying the summary. California believes that Carolina had sufficient opportunity to review those documents. In fact, to the extent that Carolina is objecting to the revenue totals, those totals are also contained in Opposer's Exhibit 17, to which accepted into evidence without objection. [O-Ex. 17; TD-Stimmler 20:11-13 (no object to Opposer's Exhibit 17)]</p> <p>In addition, other than the revenue totals reflected in Exhibit 17, Mr. Stimmler testified to</p>

	<p>the facts reflected in Exhibit 16 based on his personal knowledge. [TD-Stimmler 15:9-18:15.]</p> <p>As such, the Board need not rely on Exhibit 16 itself. California principally provided the document to the Board simply so that it could understand the context of Mr. Stimmler's testimony. [TD-Stimmler 20:14-17]</p>
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III. Response to Applicant's Objections to Testimony

A. TD-Kennedy 39:1-40:8.

Ms. Kennedy is California's licensing director and she testified that licensees typically design the products that bear California's marks and other collegiate marks licensed from other institutions of higher education.

Carolina's Objection	California's Response
<p>Relevance: Carolina purports not to understand the relevance of this testimony.</p>	<p>Since the same apparel firms may have licensees from both California and Carolina [FactStip. Ex. A], the products will be exactly identical and the only differences between a California product and a Carolina product will be the marks applied. If the marks are confusingly similar, the resulting products are by definition confusingly similar.</p> <p>This goes to the second <i>DuPont</i> factor, similarity of the goods, and shows that the goods are not only the same type of good (<i>i.e.</i> collegiate hat) but are typically the very same goods.</p>

<p>Foundation: Carolina objects that Ms. Kennedy has not necessarily dealt with each and every licensee who handles collegiate licensing. Carolina also objects that Ms. Kennedy did not specifically testify that she was familiar with her licensees stitching, cuts, or product design.</p>	<p>Ms. Kennedy has managed California's licensing program since 1988. [TD-Kennedy 9:13-25, 10:15-23.] She belongs to numerous trade organizations and has served as an officer of what is now the International Collegiate Licensing Association. [TD-Kennedy 11:4-23.] While she may not necessarily be familiar with each and every company in the industry, she has experience with hundreds of licensees and certainly has a basis in her personal experience to testify to the general realities of product licensing. Moreover, as part of the licensing process, Ms. Kennedy or those in her office review every product design submitted by a licensee and Ms. Kennedy moreover inspects products in the marketplace on a regular basis. [TD-Kennedy 12:17-20, 13:20-14:1 (each licensed product requires submission of design, pre-production sample and post production sample), 9:3-12 (marketplace visits).] Ms. Kennedy is clearly competent to testify on this point.</p>
<p>Leading: Carolina objects that the questioning was leading.</p>	<p>To the extent that the questioning was leading, it was leading only on foundational matters (where leading testimony is allowed). <i>See generally McLard v. United States</i>, 386 F.2d 495, 501 (8th Cir. 1968) ("Oftimes leading questions are asked on preliminary and collateral matters to expedite</p>

	the trial"). The witness provided the relevant substantive testimony in response to non-leading questions.
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A. TD-Kennedy 43:24-44:15.

Ms. Kennedy was asked about how Internet retailers organize goods for sale to the public on their retail sites.

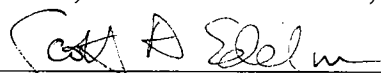
Carolina's Objection	California's Response
Foundation: Carolina contends that Ms. Kennedy's knowledge is limited to the sales of California merchandise.	Ms. Kennedy testified that on a regular basis, she reviews websites that sell collegiate merchandise. [TD-Kennedy 43:15-23.] Carolina apparently assumes that Ms. Kennedy focuses only on California merchandise and simply ignores how all collegiate merchandise is laid out. This is implausible, and California notes that Carolina elicited testimony from <i>its</i> licensing director about how internet websites work even though Carolina's licensing director has numerous duties unrelated to licensing by contrast to California's licensing director whose job duties focus on trademarks and licensing. [TD-Corbett 5:3-6:11 (added licensing duties to other non-licensing duties in 2001); TD-Kennedy 9:13-25, 10:15-23 (started in bookstore in 1988 focusing on licensing and now runs licensing department)].

Leading: Carolina objects that the questioning was leading.	To the extent any of the questions were leading, they were foundational (where leading questions are acceptable). <i>McLard v. United States</i> , 386 F.2d 495, 501 (8th Cir. 1968)
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Dated: November 17, 2006

Respectfully submitted,

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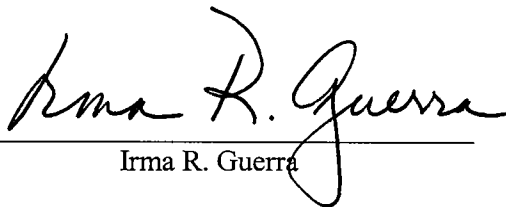
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S RESPONSE TO APPLICANT'S OBJECTIONS TO OPPOSER'S EVIDENCE** is being placed in the United States mail, first class, postage pre-paid, addressed to the following on this 17th day of November, 2006.

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